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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/539,491	03/30/2000	Gaetano Bonfiglio	Q00-1056-US1	8411

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EXAMINER

TRAN, THAI Q

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 02/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/539,491

Applicant(s)

BONFIGLIO ET AL.

Examiner

Thai Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-5, 11-15 and 21-35 is/are allowed.
- 6) ☒ Claim(s) 6-10, 16-20 and 36-40 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: _____

DETAILED ACTION

Specification

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because it is longer than 150 words.

Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 6-7 and 16-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Sugimura et al (US 6,519,411 B1).

Regarding claim 6, Sugimura et al discloses a method for retrieving multimedia information stored on a recording medium (Fig. 1 and col. 6, lines 45-62), comprising:
reading a signal recorded on the medium, the signal representing encoded packets of multimedia information, a respective corresponding encoded packet including a given first timing information in a storage timing field (col. 16, lines 6-13 and 40-47);

comparing the given first timing information in the storage timing field to a timing value from a timing generator (col. 16, lines 40-47); and

removing the given storage timing field from the respective corresponding encoded packet and outputting the respective corresponding encoded packet to a decoder when the act of comparing indicates that a respective transmission time has been reached (switching circuit 2304 of Fig. 23, col. 15, lines 50-62 and col. 17, lines 47-61).

Regarding claim 7, Sugimura et al also discloses the claimed wherein the respective transmission time is a time which is a predetermined time period earlier than a time indicated by the first timing information (col. 16, lines 40-64).

Apparatus claims 16-17 are rejected for the same reasons as discussed in the corresponding method claims 6-7 above.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 8-10 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugimura et al (US 6,519,411 B1) in view of Lane (US 6,031,960).

Regarding claim 8, Sugimura et al discloses all the features of the instant invention as discussed in claim 6 above except for providing the claimed wherein a subset of the encoded packet include second timing information outside of the storage timing field.

Lane teaches that MPEG-2 System layer has several timing information outside of the storage timing field such as program clock reference (PCR), presentation time stamp (PTS), and decoding time stamp (DTS). See col. 1, lines 41-60.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the MPEG-2 encoder/decoder as taught in Lane into Sugimura et al in order to increase the storage capacity of the recording medium of Sugimura et al because MPEG-2 encoder/decoder has high compression ratio.

Regarding claim 9, Lane discloses the claimed wherein the encoded packet output to the decoder is in a MPEG2 format (col. 1, line 61 to col. 2, line 16).

Regarding claim 10, Lane further discloses the claimed wherein the storage timing field includes a 42 bit timing value (33 bit register and 9 bit extension disclosed in col. 7, lines 61-67).

Method claims 18-20 are rejected for the same reasons as discussed in apparatus claims 8-10 above.

7. Claims 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugimura et al (US 6,519,411 B1) in view of Kato (US 6,404,711 B1).

Regarding claim 36, Sugimura et al discloses all the claimed limitations as discussed in claim 6 above except for providing a machine-readable medium having recorded therein machine-readable information, such that when the machine-readable information is read and executed by a processor within a storage device for performing the method of claim 6 above.

Kato teaches that a computer executes a program stored in a presentation medium can be used to control the digital video recorder/reproducer (col. 10, lines 45-50).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the computer as taught by Kato into Sugimura et al's system in order to facilitate the capability of controlling the digital video recorder of Sugimura et al.

Regarding claim 37, Sugimura et al also discloses the claimed wherein the respective transmission time is a time which is a predetermined time period earlier than a time indicated by the first timing information (col. 16, lines 40-64).

8. Claims 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugimura et al (US 6,519,411 B1) in view of Kato (US 6,404,711 B1) as applied to claim 36 above, and further in view of Lane (US 6,031,960).

Regarding claim 38, the combination of Sugimura et al and Kato discloses all the claimed limitations as discussed in claim 36 above except for providing the claimed wherein a subset of the encoded packet include second timing information outside of the storage timing field.

Lane teaches that MPEG-2 System layer has several timing information outside of the storage timing field such as program clock reference (PCR), presentation time stamp (PTS), and decoding time stamp (DTS). See col. 1, lines 41-60.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the MPEG-2 encoder/decoder as taught in Lane into Sugimura et al in order to increase the storage capacity of the recording medium of Sugimura et al because MPEG-2 encoder/decoder has high compression ratio.

Regarding claim 9, Lane discloses the claimed wherein the encoded packet output to the decoder is in a MPEG2 format (col. 1, line 61 to col. 2, line 16).

Regarding claim 10, Lane further discloses the claimed wherein the storage timing field includes a 42 bit timing value (33 bit register and 9 bit extension disclosed in col. 7, lines 61-67).

Allowable Subject Matter

9. Claims 1-5, 11-15, and 21-35 are allowed.

Claims 1-5 and 21-25 are directed to a method for storing multimedia information on a medium. Independent claims 1 and 21 identify the uniquely distinct feature “when the corresponding encoded packet includes the timing information, storing a value from the timing information of the corresponding encoded packet into the given storage timing field and resetting the value in the timing generator”. The closest prior art, Sugimura et al (US 6,519,411 B1) and Lane (US 6,031,960) disclose conventional digital video recorder, either singularly or in combination, fail to anticipate or render the above underlined limitation obvious.

Claims 11-15 and 26-31 are directed to an apparatus for storing multimedia information on a medium. Independent claims 11 and 26 identify the uniquely distinct feature “the timing field adder includes a timing field storer for reading and storing a value of the timing information into the storage timing field and resetting a value in the timing generator when the determiner determines that the encoded packet in the storage area includes the timing information, and the timing field storer for reading and storing the value of the timing generator into the storage timing field when the determiner determines that the encoded packet in the storage area does not include the timing information”. The closest prior art, Sugimura et al (US 6,519,411 B1) and Lane (US 6,031,960) disclose conventional digital video recorder, either singularly or in combination, fail to anticipate or render the above underlined limitation obvious.

Claims 32-35 are directed to a machine-readable medium having recorded therein machine-readable information, such that when the machine-readable information is read and executed by a processor within a storage device for storing multimedia information. Independent claim 32 identifies the uniquely distinct feature "when the corresponding encoded packet includes the timing information, storing a value from the timing information of the corresponding encoded packet into the given storage timing field and resetting the value in the timing generator". The closest prior art, Sugimura et al (US 6,519,411 B1) and Lane (US 6,031,960) disclose conventional digital video recorder, either singularly or in combination, fail to anticipate or render the above underlined limitation obvious.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The cited references relate to digital video recorder.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (703) 305-4725. The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.


THAI TRAN
PRIMARY EXAMINER